

**REMARKS**

A Petition for Extension of Time is being concurrently filed with this Reply.

***Status of the Claims***

Claims 1-15 are pending in the present application. No claims are being amended, added or canceled. Thus, a listing of the claims is not needed.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Issues Under 35 U.S.C. § 102(e)***

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Tomita *et al.* (U.S. Patent No. 6,436,723; hereinafter "Tomita '723"). Applicants respectfully traverse in that not all instantly claimed features are disclosed in the Tomita '723 reference.

The cited Tomita '723 reference discloses a method of manufacturing **a semiconductor device**, comprising the steps of: forming a first metal compound film on **a semiconductor substrate**, the first metal compound film being formed of metal elements, at least one of which has compound which is difficult to dissolve in water; forming a second metal compound film on the first metal compound film, the second metal compound film being formed of metal elements, each of which makes an easily water-soluble or a volatile compound; forming a protection film having a desired aperture, on the second metal compound film; and etching the second metal

compound film exposed from the aperture, by a solution of water containing ozone (see the Office Action at page 3, third full paragraph and Tomita '723 at column 3, lines 40-52).

The disclosure in Tomita '723 is not the same as the present invention. The present invention is directed to a method of manufacturing a phase shift mask blank or a phase shift mask (see, e.g., pending claim 1). Just being directed to the production of the phase shift mask blank or a phase shift mask is different from the Tomita '723 disclosure. Also, the phase shift mask blank of the present invention comprises a transparent substrate and at least one layer of phase shift film. Tomita '723 fails to disclose, e.g., this transparent substrate. Accordingly, Applicants respectfully submit that the phase shift mask blank and phase shift mask are different from semiconductor devices, such as that disclosed in the cited Tomita '723 reference, and the transparent substrate used for phase shift mask blank is not a semiconductor substrate such as a silicon wafer. Therefore, this rejection has been overcome.

This is because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," wherein the cited Tomita '723 reference cannot be a basis for a rejection under § 102(e). *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Tomita '723 is overcome. Reconsideration and withdrawal are respectfully requested.

The Examiner mentions the above difference between the present invention and cited reference in the Office Action at page 6 lines 8 to 10. However, Applicants note that in the presently method directed to the manufacturing a phase shift mask blank, the surface of the

phase shift film is treated with ozone water. This treatment is not an etching step such as removing the second metal compound film as disclosed in the cited reference (see, e.g., Fig. 2C in the Tomita '723). A phase shift film is not removed in manufacturing process of a phase shift mask blank. This is an additional reason as to why this anticipatory rejection has been overcome.

***Issues Under 35 U.S.C. § 103(a)***

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomira '723 or Konuma (U.S. Patent No. 6,127,279; hereinafter "Konuma '279") in view of Tanaka *et al.* (U.S. Patent No. 6,667,135; hereinafter "Tanaka '135"). Applicants respectfully submit that both of these rejections are rendered moot.

Specifically, the cited secondary reference of Tanaka '135 is a continuation of Application No. 09/924,769, which was filed on August 9, 2001 and eventually issued as the '135 patent on December 23, 2003. Still, the priority date of Tanaka '135 would appear to be August 15, 2000 (see item (30) on the patent cover). However, this priority date of Tanaka '135 is not a filing date under 35 U.S.C. § 102(e) according to the *Hilmer* Doctrine (see also M.P.E.P. § 2136.03(I); see also M.P.E.P. § 201.15). In other words, Tanaka '135 cannot have a § 102(e) date back to its own Japanese priority document having the 2000 date.

On the other hand, the priority date of the present application is August 6, 2001 (corresponding to Japanese Application No. 2001-237670). Applicants also note that a translation of the Japanese priority document for the present application has already been filed (on August 6, 2002 in the parent application, and filed concurrently with the filing of this

application on June 27, 2003) and thus priority has been perfected. Thus, the August 6, 2001 date is the priority date of this application, and this application's Japanese priority date is before the August 9, 2001 date of the Tanaka '135 patent.

Also, under the provisions of 35 U.S.C. § 102(a), Tanaka '135 is not before the priority date of this application. The phrase "in this country" of § 102(a) means Tanaka '135 cannot go back to its August 15, 2000 date. Similarly, the other phrase "patented or described in a printed publication" of § 102(a) refers to, at best, the February 21, 2002 date (see item (65) of the patent cover) of Tanaka '135.

Further, under the provisions of 35 U.S.C. § 102(b), Tanaka '135 is not before the priority date of this application due to the U.S. filing date of the parent application (August 6, 2002) that is related to this application.

Accordingly, Tanaka is not effective as prior art under 35 U.S.C. §§ 102(e)/103(a) (or any other subsection of § 102) to the present invention and both rejections citing the secondary reference of Tanaka '135 are rendered moot or has been obviated. Thus, withdrawal of these rejections under 35 U.S.C. § 103(a) is respectfully requested.

***PTOL-302 Form***

Applicants respectfully request clarification as to U.S. Patent No. 6,436,723 (at page 2 of the Office Action) versus U.S. Patent No. 6,436,732 (to Ahmad) listed on the PTOL-302 form.

**Application No. 10/606,894**  
**Art Unit 1756**  
**Reply to Office Action of October 3, 2005**

**Docket No.: 0171-0983P**

***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: February 3, 2006

Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant